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SNELL & WILMER LLP  
1920 MAIN STREET  
SUITE 1200  
IRVINE, CA 92614-7230

EXAMINER

PARSLEY, DAVID J

ART UNIT PAPER NUMBER

3643

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/757,116	<b>Applicant(s)</b> ALEXANDER, KAROLEEN B.	
	<b>Examiner</b> David J. Parsley	<b>Art Unit</b> 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 22-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-15-04</u> . | 6) <input type="checkbox"/> Other: _____  |

*R*

## Detailed Action

### *Election/Restrictions*

1. Applicant's election of Group I (claims 1-21) in the reply filed on 4-7-05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 22-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 4-7-05.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Claim 1 includes two base layers and therefore it is unclear to which of the base layers the binder is on top of.

Claims 2-21 depend from rejected claim 1 and include all of the limitations of claim 1 thereby rendering these dependent claims indefinite.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to which of the base layers is to be butadiene rubber.

Claims 15 and 19 recite the limitation "the wear layer" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "the wear layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over 5,396,731 to Byrne in view of U.S. Patent No. 5,678,353 to Tsao et al.

Referring to claim 1, Byrne discloses a structure for use as a tree well skirt or sidewalk comprising, a base layer – at 15 or 16, of rubber and a binder – see for example column 4 lines

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53-68 and column 5 lines 1-22, and a base layer – at the other of 15 or 16, of rubber and a binder on top of the base layer – see for example figures 1-8 and columns 4-5. Byrne does not disclose a base layer is made of EPDM. Tsao et al. does disclose a base layer – at 1-4 made of EPDM – see for example claim 13 column 10 lines 4-14. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne and add the base layer made of EPDM of Tsao et al., so as to allow for the device to be durable for outdoor use.

Claims 2-3, 6-11, 12/10, 12/11, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,730,773 to Farley.

Referring to claim 2, Byrne as modified by Tsao et al. does not disclose the base layer is butadiene rubber. Farley does disclose the base layer is butadiene rubber – see for example column 4 lines 28-44. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and add the base layer of butadiene rubber of Farley, so as to allow for the device to be flexible and resilient.

Referring to claim 3, Byrne as modified by Tsao et al. and Farley further discloses the rubber is recycled vehicle tires or industrial rubber – see for example column 4 lines 17-27 of Byrne and column 4 lines 28-44 of Farley.

Referring to claim 6, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in granular form – see for example column 4 lines 17-27 of Byrne and column 4 lines 33-67 of Farley.

Referring to claim 7, Byrne as modified by Tsao et al. and Farley further discloses the rubber granules are in the range of 1.5mm to 6mm – see for example column 4 lines 17-27 of Byrne.

Referring to claim 8, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in the form of peelings or buffings – see for example column 4 lines 17-27 of Byrne.

Referring to claim 9, Byrne as modified by Tsao et al. and Farley further discloses the rubber is in the form of a mixture of granules and peelings and buffings – see for example column 4 lines 17-27 of Byrne.

Referring to claims 10-11, Byrne as modified by Tsao et al. and Farley does not disclose the mixture of granules to peelings or buffings is either 70% granules and 30% peelings or buffings or 50% granules and 50% peelings or buffings. However, these are limitations found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the mixture of either 50 or 70% buffings and either 30 or 50% peelings or buffings, so as to allow for the device to be of a natural appearance.

Referring to claims 12/10 and 12/11, Byrne as modified by Tsao et al. and Farley further discloses the rubber is recycled vehicle tires or industrial rubber – see for example column 4 lines 17-27 of Byrne and column 4 lines 28-44 of Farley.

Referring to claims 13-14, Byrne as modified by Tsao et al. and Farley does not disclose the base layer is 1 ½ to 3 ½ inches or 2 inches thick. However, these limitations are found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the base layer being 1 ½ to 3

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½ inches or 2 inches thick, so as to allow for the device to be made of sufficient size to make the device durable for outdoor use.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. and Farley as applied to claim 2 above, and further in view of U.S. Patent No. 4,882,386 to Stella.

Referring to claim 4, Byrne as modified by Tsao et al. and Farley does not disclose the binder is isocyanate polyurethane. Stella does disclose the binder is isocyanate polyurethane – see for example column 9 lines 19-26. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Farley and add the binder being isocyanate polyurethane of Stella, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 5, Byrne as modified by Tsao et al., Farley and Stella does not disclose the ratio of binder to rubber is 16% by weight. However, this limitation is found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al., Farley and Stella and add the ratio of binder to rubber being 16% by weight, so as to allow for the device to be strengthened and thus more durable.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of Stella.

Referring to claim 15, the binder is isocyanate polyurethane. Stella does disclose the binder is isocyanate polyurethane – see for example column 9 lines 19-26. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by

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Tsao et al. and add the binder being isocyanate polyurethane of Stella, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 16, Byrne as modified by Tsao et al. and Stella does not disclose the ratio of binder to rubber is 20% by weight. However, this limitation is found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Stella and add the ratio of binder to rubber being 20% by weight, so as to allow for the device to be strengthened and thus more durable.

Referring to claim 17, Byrne as modified by Tsao et al. and Stella further discloses the rubber is granular – see for example column 4 of Byrne.

Referring to claim 18, Byrne as modified by Tsao et al. and Stella further discloses the rubber granules are in the range of 1.5mm to 6mm – see for example column 4 lines 17-27 of Byrne.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne as modified by Tsao et al. as applied to claim 1 above, and further in view of U.S. Patent No. 4,205,102 to Schuurink et al.

Referring to claim 19, Byrne as modified by Tsao et al. does not disclose the binder contains aliphatic diisocyanate. Schuurink et al. does disclose the binder contains aliphatic diisocyanate – see for example claim 3. Therefore, it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and add the binder containing aliphatic diisocyanate of Schuurink et al., so as to allow for the device to be strengthened and thus more durable.



Referring to claim 20, Byrne as modified by Tsao et al. and Schuurink et al. further discloses the rubber is granules and the granules are in the range of 1.5mm to 6mm in diameter – see for example column 4 lines 17-27 of Byrne.

Referring to claim 21, Byrne as modified by Tsao et al. and Schuurink et al. does not disclose the base layer 2 to 3 inches thick and the wear layer is 3/8 to 1/2 inch thick. However, these limitations are found through experimentation and it would have been obvious to one of ordinary skill in the art to take the device of Byrne as modified by Tsao et al. and Schuurink et al. and add the base layer being 2-3 inches thick and the wear layer being 3/8-1/2 inch thick, so as to allow for the device to be of sufficient size to be durable for outdoor use while not being too bulky for transport.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to tree skirts in general:

U.S. Pat. No. 1,554,865 to Magoon – shows tree skirt

U.S. Pat. No. 3,571,972 to Carter – shows tree skirt

U.S. Pat. No. 3,673,134 to Anderson – shows tree/plant device made of EPDM

U.S. Pat. No. 4,928,443 to Goodman et al. – shows tree skirt

U.S. Pat. No. 5,058,317 to McMurray – shows tree skirt

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U.S. Pat. No. 5,065,543 to Brook – shows tree skirt

U.S. Pat. No. 5,085,001 to Crawley – shows tree skirt

U.S. Pat. No. 5,212,904 to Green et al. – shows tree fertilizing apparatus

U.S. Pat. No. 5,502,921 to Hyslop – shows tree skirt

U.S. Pat. No. 6,360,480 to Christensen – shows tree skirt


DE Pat. No. 4108994 – shows plant/tree device made of rubber and EPDM

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Parsley whose telephone number is (571) 272-6890.

The examiner can normally be reached on 9hr compressed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Parsley  
Patent Examiner  
Art Unit 3643

  
PETER M. POON  
SUPERVISORY PATENT EXAMINER

6/10/05